

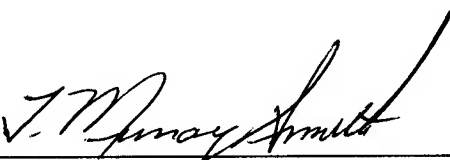
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		2003-0571 / 24061.112	
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	10/806,967	March 23, 2004	
	First Named Inventor		
	Mao-I Wu, et al.		
	Art Unit	Examiner	
	2457	Ramy M. Osman	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		T. Murray Smith	
		Typed or printed name	
<input checked="" type="checkbox"/> attorney or agent of record.	30,222	(972) 739-8647	
Registration number		Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.		January 20, 2010	
Registration number if acting under 37 CFR 1.34		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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### REASONS

This is an appeal from the final rejection mailed on August 20, 2009. An After-Final Amendment filed on November 19, 2009 has been entered. Claims 2–5, 7–12, 14–17, and 19–20 are currently pending in this application, and are all rejected. It is respectfully submitted that, as discussed below, the claim rejections each have a clear legal deficiency, are clearly not proper, and are without basis.

#### Rejection Under 35 U.S.C. § 101

Claims 14–17 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. In an Advisory Action mailed December 23, 2009, this rejection was withdrawn. The rejection is thus moot and will not be addressed herein.

#### The First Paragraph of 35 U.S.C. § 112

Claims 2–5, 7–12, 14–17, and 19–20 are rejected under the first paragraph of § 112, based on an assertion that the recitation in Claim 1 of “denying the first router any access to the second network” is not supported in the specification. In particular, on page 4 of the Office Action, the Examiner states that “[t]here is no mention of the second network, or any other entity, denying access to the first router, and how this is performed.” Applicants respectfully traverse this rejection.

Claim 1 was previously canceled, and so the Examiner’s discussion of Claim 1 is moot. Applicants note that Claims 4 and 16 recite “denying the first router any access to the second network,” and Claim 19 recites “the first router is denied access to the company intranet.” Applicants will thus assume, for purposes of responding to the Office Action, that the Examiner meant to refer to Claims 4, 16, and 19 when discussing claim language that recites “denying.”

MPEP § 2111 states that “claims must be ‘given their broadest reasonable interpretation consistent with the specification.’” On pages 2–4 of the Office Action, the Examiner improperly adopts an unduly narrow interpretation of the claim language “denying,” by twice asserting that:

“Denying’ occurs only in the presence of a requestor and a denier, where the requestor is denied by the denier. In this case, the first router would be the requestor. And in this case, Applicants disclosure does not support ‘denying’.

However, this interpretation fails to comply with MPEP § 2111, because it is narrower than the “broadest reasonable interpretation” of “denying.” By way of example and not limitation, “denying” may occur without a requestor, for example when a physical structure is configured to prevent access to something, such as a network. On page 6 of the Office Action, in a different rejection, the Examiner interprets the term “denying” more broadly than in the § 112 rejection, stating that “‘denying the first router any access to the second router’ . . . is therefore broadly interpreted to mean denying a user of one network to access the other network.” Thus, the Examiner clearly recognizes on page 6 that “denying” does not require a requestor and a denier, in direct contrast to the Examiner’s contentions on page 4 of the Office Action. Accordingly, the

Examiner's § 112 rejection has unnecessarily narrowly interpreted the meaning of "denying the first router any access to the second network," by failing to give this language its "broadest reasonable interpretation."

In any event, the present application provides support for "denying" as recited in the claims. In this regard, MPEP § 2163(I)(B) provides that "[t]he claims as filed in the original specification are part of the disclosure." Further, the second paragraph of § 112 specifies that the original claims are part of the specification. In the present application, originally-filed Claims 6 and 18 each recited "denying the first router any access to the second network." In previous Responses filed on October 3, 2008 and April 16, 2009, this limitation from original Claim 6 was incorporated into Claim 1, which in turn was incorporated into presently-pending Claim 4. Similarly, this limitation from original Claim 18 was incorporated into Claim 13, which in turn was incorporated into presently-pending Claim 16. Since this limitation was present in the originally-filed claims, the present application (as originally filed) provides support for "denying the first router any access to the second network," as presently recited in Claims 4 and 16.

Further, considering the specification and drawings, the present application clearly enables one of ordinary skill in the art the ability and know-how for "denying the first router any access to the second network" and for ensuring "the first router is denied access to the company intranet." Originally-filed Fig. 3 of the present application is reproduced below. By way of example and not limitation, it is clear from Fig. 3 that a router 312 can access both a network 324 and an intermediate network 326. In contrast, a router 304 can access only the network 324, and is clearly denied access to the intermediate network 326.

Regarding Fig. 3, the originally-filed specification provides in paragraphs [0024]–[0025], [0047]–[0048], and [0053] that "the router 304 may route the connection from the access point 302 to the proxy server 306," "the proxy server 306 may provide the external entity with an access to the network 324," and an "[e]xemplary configuration for the proxy server 306" includes "deny[ing] company intranet web access," while "allow[ing] all Internet web access." Thus, Fig. 3 and the accompanying description clearly support the recitation in

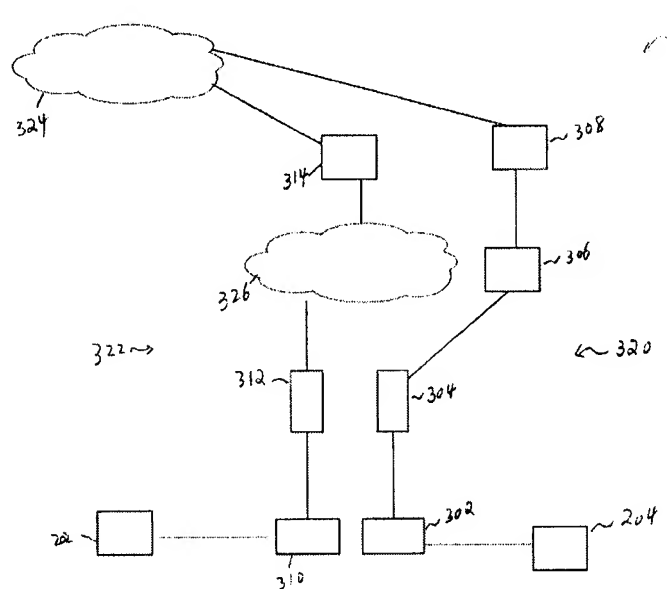


Fig. 3

Claims 4 and 16 of "denying the first router any access to the second network," and the recitation in Claim 19 of "the first router is denied access to the company intranet." A person of ordinary skill in the art can easily build and use what is shown in Fig. 3, and the present application thus provides an enabling disclosure of a system that inherently involves "denying" as recited in the claims.

Moreover, MPEP § 2164.01 discusses the standard for meeting the enablement requirement in the first paragraph of § 112, providing that “even though the statute does not use the term ‘undue experimentation,’ it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation” (emphasis added). In light of the foregoing, the present specification, coupled with information known in the art, clearly enables one reasonably skilled in the art to easily build the system of Fig. 3 and thus accomplish “denying the first router any access to the second network” without undue experimentation.

For the foregoing reasons, Applicants respectfully submit that the present application as originally filed (including the specification and drawings) fully enables one of ordinary skill in the art to make and use Applicants’ system for “denying,” and specifically enables one of ordinary skill in the art to accomplish “denying the first router any access to the second network” as recited in Claims 4 and 16, and to ensure “the first router is denied access to the company intranet” as recited in Claim 19. Thus, Applicants respectfully submit that the § 112 first paragraph rejections are without basis, and thus in clear error.

#### Independent Claims 4, 16, and 19

The Office Action rejected Claims 4, 16, and 19 under 35 U.S.C. § 103 on the ground that it would be obvious to modify Myers U.S. Patent Application Publication No. 2004/0122956 in view of Kim U.S. Patent Application Publication No. 2005/0005110 and Hericourt U.S. Patent No. 6,792,461. This ground of rejection is respectfully traversed.

MPEP § 2142 specifies that “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP § 706.02(j) sets forth minimum requirements an examiner must meet in order to properly establish a *prima facie* case of obviousness under § 103. One of these minimum requirements is that an examiner must set forth “an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.” MPEP § 2142 further emphasizes that the “Federal Circuit has stated that ‘rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’” Here, the teachings drawn from Myers, Kim, and Hericourt fail to establish a *prima facie* case of obviousness under § 103 with respect to Claims 4, 16, and 19 because the Examiner does not provide a valid reason for modifying Myers in view of Hericourt.

With respect to Claims 4, 16, and 19, the Examiner admits on page 7 of the Office Action that “Myers and Kim fail to explicitly teach routing to a proxy server through the first router.” The Examiner therefore turns to Hericourt, asserting that it would be obvious to modify Myers in view of Hericourt so that the system of Myers can provide for proxy caching. Specifically, on page 7 of the Office Action, the Examiner proposes the following reason or “motivation” for making the proposed modification to Myers in view of Hericourt:

One would be motivated to do so for the purpose of utilizing the proxy servers as cache servers in order to locally cache HTTP data from the Internet and then provide it to a

workstation that sends a request for that particular HTTP data, and which increases efficiency.

In the Advisory Action, the Examiner states that “[t]he Examiner is only concerned that Myers does not provide proxy caching. Which indeed is the case. Myers fails to teach proxy caching which is then remedied by the teachings of Hericourt.”

This reasoning is flawed. In fact, the Examiner offers comments supporting Applicants’ assertion that the motivation proposed by the Examiner is not sufficient to support a *prima facie* case of obviousness, because it would not actually motivate a person of ordinary skill to make the proposed modification to Myers. On page 3 of the Office Action, the Examiner states “the rejection did not state that Myers fails to provide caching. The mentioned local caching in the rejection is local to the proxy, ie proxy caching.” But this is exactly Applicants’ point. In particular, for one of ordinary skill in the art to be motivated into “utilizing the proxy servers [of Hericourt] as cache servers in order to locally cache HTTP data from the Internet” so as to increase the efficiency of the Myers system as the Examiner contends, it must first be established that Myers fails to provide for caching data, or that even if Myers caches data, Myers does so inefficiently, such that additional layers of caching ability are needed. But there is no evidence to support the notions that (1) the system of Myers cannot cache data or (2) the system of Myers cannot cache data efficiently without additional layers of caching. Consequently, there is no motivation for modifying Myers in view of Hericourt to provide additional, different caching capabilities (*i.e.*, proxy caching). Instead, one of ordinary skill in the art would recognize that combining Myers and Hericourt would result in a more expensive and complex configuration. Since the Examiner agrees that Myers provides caching, and has failed to show that Myers does so inefficiently, there is no reason to incur the added expense and complexity of combining Hericourt’s proxy server with the system of Myers, because there is no reason to expect any added benefit.

Further supporting Applicants’ position, the Myers specification, coupled with information already known in the art, would lead one of ordinary skill in the art to recognize that (1) the system of Myers can cache data and (2) there is no reason to believe Myers caches data inefficiently (other than improper use of hindsight by the Examiner). More particularly, the Examiner and Applicants agree that at the time the present application was filed, local caching of Internet data was very well known in the art. In the Advisory Action, the Examiner states that “there are plenty of examples of current and old well-known networks having multiple layers of caching (at different points throughout a network).” Accordingly, one of ordinary skill in the art would readily recognize that the system of Myers is entirely capable of caching Internet data efficiently without the use of Hericourt’s proxy server for additional proxy caching. For example, Myers explains in paragraphs [0041] and [0051] that “mobile units 30 associated with customers and partners are provided access to the Internet 56,” and that the mobile units can be “a laptop, personal digital assistant (PDA) or other device.” One of ordinary skill in the art would recognize, based on industry-standard technology, that the mobile units 30 of Myers presumably already provide Internet caching (for example via standard web

browsers utilized to access the Internet), thereby making it completely unnecessary to add a proxy server for the purpose of performing these same caching functions. Accordingly, the motivation proposed by the Examiner is not sufficient to support a *prima facie* case of obviousness, because it would not actually motivate a person of ordinary skill to make the proposed modification to Myers.

It appears that the idea to modify Myers in view of Hericourt is not coming from what was known before the present invention, but instead is coming from hindsight of Applicants' disclosure. In particular, using Applicants' disclosure as a blueprint, the Examiner has selectively extracted isolated features from Myers, Kim, and Hericourt, and has then combined these isolated features with a 20/20 hindsight view of the desired result. However, the proper inquiry is whether, if Applicants' disclosure is completely ignored, there is any reason that would prompt a person of ordinary skill to make the proposed modification of Myers in view of Kim and Hericourt. Here, a person of ordinary skill in the art would recognize that the system of Myers is apparently already capable of efficiently caching data (as the Examiner admits), and since there is no reason to believe that Myers's system caches data inefficiently, the Examiner has not identified any valid reason that would prompt the proposed modification of Myers to add the proxy server of Hericourt to provide for additional, different caching abilities.

In view of each of the reasons discussed above, it is respectfully submitted that the Examiner has failed to properly establish a *prima facie* case of § 103 obviousness for Claims 4, 16, and 19 based on Myers, Kim, and Hericourt. Accordingly, the § 103 rejection of Claims 4, 16, and 19 is clearly not proper and is without basis, and it is respectfully requested that it be withdrawn.

#### Dependent Claims

Claims 2-3, 5, and 7-12, Claims 14-15 and 17, and Claim 20 respectively depend from Claim 4, Claim 16, and Claim 19, and are also believed to be patentable, for example for the same reasons discussed above in association with Claims 4, 16, and 19, respectively.

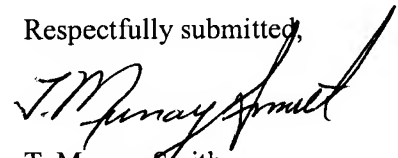
#### Conclusion

As discussed above, the rejections each fail to meet minimum PTO requirements for such rejections, and therefore each have a clear legal deficiency. Consequently, these rejections are clearly not proper and are without basis, and it is respectfully requested that these rejections be withdrawn.

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